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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,966	02/10/2006	Arnold Keller	246472009300	5675
25227 7590 04/01/2010 MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 400 MCLEAN, VA 22102				
EXAMINER				
COMSTOCK, DAVID C				
ART UNIT		PAPER NUMBER		
3733				
MAIL DATE		DELIVERY MODE		
04/01/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/567,966

**Applicant(s)**

KELLER, ARNOLD

**Examiner**

DAVID COMSTOCK

**Art Unit**

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CG-600)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 2/10/06, 8/28/09, 10/9/09

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Olerud (4,827,918).

Olerud clearly discloses the claimed invention including a bone spreader for spreading bones apart (Fig. 1) comprising a parallel guide system with a guide bar 2, tubular pin holders 9, which are connected to one another by the parallel guide system, and are configured to receive pins 20 that are axially introduced into the pin holders (id. and, e.g., col. 1, lines 8-55). The pins connect to bone to be spread apart and comprise transverse grooves 25 (Fig. 4). The pin holders include a locking device comprising a locking finger, e.g. 27, which is guided between a locking position and a release position in a transverse movement tangentially with respect to the pin holder. The locking finger engages the groove in the locking position, and the tubular pin holders are arranged in planes which are perpendicular to the guide bar. The locking finger is in the form of a hook, as by its pointed and laterally extending configuration, and is pivotably mounted at an open end of the pin holder with its axis parallel thereto. The device is used to spread

apart bone (see, e.g., col. 1, lines 15-18). The method is inherent in an ordinary use of the device (see, e.g., col. 4, line 41 - col. 5, line 48).

### ***Response to Arguments***

Applicant's arguments filed 01 October 2009 have been considered but are moot in view of the new grounds of rejection. It is noted that the previous grounds of rejection have been withdrawn by Examiner without prejudice in favor of a newly discovered clear ground of rejection under 35 U.S.C. 102(b) that is being applied to new claims 3-6, and that clearly applies to claims 1 and 2 as well. For the record, and with regard to the previous grounds of rejection, it is first noted that the references are believed to be analogous at least because of their common searches. Specifically, while Examiner agrees that a person having ordinary skill in the art of medical devices would have no reason to search motorcycle accessories per se, the Nicosia et al. reference is directed primarily to a latching assembly as described in the title. Moreover, it is classified in classes 70 and 403, which deal with locks, and joints and connections, respectively, and both of these classes would be searched by a person of ordinary skill attempting to provide a better or alternative joint or locking connection. In addition, text searches for the features of the invention would bring up art including Nicosia et al., as evidenced by its very existence and application in the record. Therefore, Nicosia is still considered to be directed to the particular problem with which Applicant was concerned and appears to be analogous art. Next, it is noted that Young discloses not only the embodiments shown in the figures but also embodiments including structure comprising eyebolts

(tubular pin holders) and rods (pins) that appear to satisfy the claims (see, e.g., col. 4, lines 34-47). However, this aspect is not clearly described in Young and would require further analysis were the grounds maintained. In response to other arguments by Applicant, the threaded interface provides the original locking means that is substituted by the simple and secure alternative mechanism as taught by Nicosia et al. A structure with pins engaged in pin holders is patentably indistinguishable from a structure that does the same after pins have been axially introduced therein. Thus, the resulting structure does appear to be the same absent evidence that the process of axially introducing the pins results in a different product. In any event, the rods (pins) and eyebolts (tubular pin holders) would likely satisfy this limitation as the pins would need to traverse the axis of the eyebolts to be secured therein. This discussion should make clear that Nicosia et al. is analogous art to devices (including medical) open to modification/substitution of joints and connections therein. It should also at least clarify that Young discloses more embodiments than simply the one exemplified in the figures. This discussion is made in the event that either of these references become material through future amendments or arguments by Applicant. In any event, the previous grounds of rejection are withdrawn without prejudice in light of the newly discovered reference to Olerud, which clearly anticipates the claims, as set forth above.

### ***Conclusion***

This action is non-final because the rejection of claims 1 and 2 as set forth above was not necessitated by Applicant's amendment.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710 (a detailed message should be left if Examiner is unavailable). If attempts to reach the Examiner by telephone or voicemail are unsuccessful, the examiner's supervisor, Eduardo Robert, can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David Comstock/

Examiner, Art Unit 3733

/Nicholas D Lucchesi/

Supervisory Patent Examiner, Art Unit 3763